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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/009,160

12/06/2001

Manfred Wiedemer

P01,0352

8651

26574

7590

03/10/2006

SCHIFF HARDIN, LLP  
PATENT DEPARTMENT  
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EXAMINER

NGUYEN, ANTHONY H

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/009,160

Applicant(s)

WIEDEMER ET AL.

Examiner

Anthony H. Nguyen

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 20-40 is/are pending in the application.
- 4a) Of the above claim(s) 34-38 and 40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-33 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/06/2001</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Applicant's election of Group I, claims 20-33 and 39 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Accordingly, claims 34-38 and 40 are withdrawn from further consideration by the examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

#### ***Specification***

The disclosure is objected to because of the following informalities: the Brief Description of the Drawings does not includes the Fig.3A and Fig.3B. Appropriate correction is required.

#### ***Drawings***

The drawings are objected to because the reference characters are not in English.

#### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless

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the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Claim Objections***

Claims 20-33 are objected to because the language "when printing a picture element dependent...the first surface tension" is vague in that it is unclear how the first surface tension can moisten the carrier material without significant change in volume. Additionally, there is no proper antecedent basis for "the depressions" (claim 29, line 1 and 2). In claim 33 line 3, the word "off" should obviously be --of--.

### ***Claim Rejections - 35 U.S.C. § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 20-24, 26-33 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Gundlach (US 3,655,379).

With respect to claims 20,22,23, 26, 28, 32 and 39, Gundlach teaches the method for transferring printing fluid 26 onto the carrier material 27 by influencing a surface tension of the printing fluid. The printing fluid is not transferred to the carrier material when the surface tension is not influenced (Gundlach, Figs.1 and 2, col.3, second paragraph). Note that the surface tension of the printing liquid is inherently changed so that the surface of the printing liquid is

arced outward or inward corresponding to the surface tension of the printing liquid which has a variety of values when the printing liquid is subjected to the changes of temperature or light.

With respect to claim 21, the surface tension of the printing liquid 26 in a depression, which is selected for printing, is greater than the surface tension of the printing liquid in the depressions (which are not selected for an image) above or below the printing liquid 26 shown in Fig.2 of Gundlach since the printing liquid 26 is influenced by the light 29.

With respect to claims 24 and 27, Gundlach teaches the use of a color printing fluid and additives or color pigments (Gundlach, col.2 lines 27-39).

With respect to claims 30 and 31, Gundlach teaches the use of a radiation source for influencing the printing liquid (Gundlach, col.3, line 11).

With respect to claim 33, the carrier material 27 of Gundlach lies against the drum or an acceptance unit 17.

### ***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 25 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Gundlach (US 3,655,379) in view of Inoue et al. (US 4,748,458).

Gundlach teaches the method for transferring printing fluid onto the carrier material having substantially the steps as recited. Gundlach does not teach the step of changing the

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surface tension by varying an ionization of the printing fluid. Inoue et al. teaches the step of changing the surface tension of a printing fluid 6 by ionization the printing liquid which is subjected to an electric field between the electrode 14 and the conductive layer 12 in the recording head 1 as shown in Fig.2 of Inoue et al. In view of the teaching of Inoue et al., it would have been obvious to one of ordinary skill in the art to modify the method of Gundlach by providing the step of changing the surface tension of the printing liquid by varying an ionization of the printing fluid as taught by Inoue et al. for simplicity design of a printing apparatus.

Claim 29 is rejected under 35 U.S.C. § 103 (a) as being unpatentable over Gundlach (US 3,655,379) in view of Wiedemer (US 5,760,808).

Gundlach teaches the method for transferring printing fluid onto the carrier material having substantially the steps as recited. Gundlach does not clearly teach the use of depressions which are arranged on a drum-shaped surface. Wiedemer teaches the conventional use of a printing drum 10 which includes depressions 30 which are arranged in a matrix form on the surface of the printing drum as shown in Figs. 2 and 3 of Wiedemer. In view of the teaching of Wiedemer, it would have been obvious to one of ordinary skill in the art to modify the depressions of Gundlach by providing the depressions which are arranged on the surface of a drum as taught by Wiedemer for quickly printing of a selected image onto a carrier material.

### *Conclusion*

The patents to Iino et al., Machida, Dietzell et al., Fujimura et al., Bupara and Hendricks are cited to show other methods having obvious similarities to the claimed method.

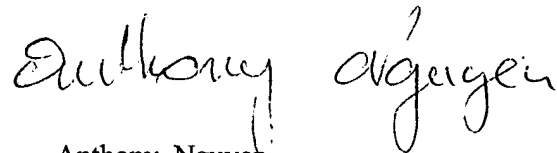
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Nguyen whose telephone number is (571) 272-2169.

The examiner can normally be reached daily from 9 AM to 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld, can be reached on (571) 272-2168.

The fax phone number for this Group is (571) 273-8300.

A handwritten signature in cursive script that reads "Anthony Nguyen".

Anthony Nguyen  
3/9/06  
Patent Examiner  
Technology Center 2800